

#8

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of:

CHRISTIANSEN et al.

Application No.: 09/097,383

Filed: June 16, 1998

FOR: LIGHT PULSE GENERATING APPARATUS AND COSMETIC  
AND THERAPEUTIC PHOTOTREATMENT



Group Art Unit: 3739

Examiner: Shay, David M.

TC 3700 MAIL ROOM  
JUN 14 2000  
June 14, 2000

RECEIVED

REPLY

Hon. Commissioner of Patents  
Washington, D.C. 20231

Sir:

In response to the Office Action of May 11, 2000, Applicants elect, with traverse, the Group I claims which currently are claims 1-5, 7-9 and 19-26.

The Examiner has suggested that Groups I and II are distinct because although related as a process and apparatus for its practice, the device could be used for surgery. This would appear to be intended as an example satisfying the condition that "(2) apparatus as claimed can be used to practice another and materially different process". In fact, it is surely clear that all the Examiner has done is to substitute the word "surgery" for "therapeutic phototherapy" without any analysis as to why there is a material difference between these processes. The only way in which the apparatus of claim 1 could be used for surgery in accordance with claim 6 is by directing its light output onto a patient to effect some surgical change such as blood coagulation. That is merely one example of the use of the apparatus for therapeutic phototherapy. It is therapeutic. That is the nature of surgery. It is phototherapy because the surgical process involved would depend upon the application of light. The Examiner is merely playing with words.

CHRISTIANSEN et al. - 09/097,383



The same criticism applies to the objection in relation to Inventions II and III. Once again, the Examiner says that the device could be used for surgery whereas method claim 6 calls this process therapeutic phototherapy. There is no material difference. One is merely an example of the other.

Exactly the same objections arise in connection with the objection in relation to Inventions II and IV. Exactly the same argument applies against the objection to the distinctness of Inventions II and V.

Inventions I and III have been objected to as distinct because Invention I has a separate utility such as surgery. However, as the Examiner has pointed out earlier in the official action, Invention III has the same surgical utility. Thus, this is not a separate utility of Invention I. The same comments apply to the objections to Inventions I and IV and Inventions I and V as well as to the objections against Inventions III and IV and Inventions III and V and again the objection to Inventions IV and V.

Thus, the reasons given by the Examiner clearly do not support the objection and examination should proceed in respect of all of the claims. Withdrawal of the election requirement is respectfully requested.

Respectfully submitted,

PILLSBURY MADISON & SUTRO, LLP

By: 

G. Lloyd Knight  
Reg. No. 17,698  
Tel. No.: (202) 861-3090  
Fax No.: (202) 822-0944

1100 New York Ave., N.W.  
Ninth Floor - East Tower  
Washington, D.C. 20005  
(202) 861-3000

30063730\_1.DOC